

REMARKS

Claims 1 through 15 are pending in this application, of which claims 9 through 15 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b). Accordingly, claims 1 through 8 are active.

Claim 1 has been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, Figs. 1 and 2 and the related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not any new matter issue.

Claims 1, 2, 5, 6 and 8 were rejected under 35 U.S.C. §103 for obviousness predicated upon Fujiwara et al. in view of Asami et al.

In the statement of the rejection the Examiner referred to Fig. 2A of Fujiwara et al., asserting the disclosure of a solid electrolytic capacitor comprising, *inter alia*, anode 1, dielectric layer 3, presumably intending dielectric layer 4, and metal layer/silver paste 8a, which the Examiner viewed as being formed on the surface of dielectric layer 4. The Examiner apparently interpreted the word “on” to mean “over”. The Examiner then concluded that one having ordinary skill in the art would have been motivated to modify the capacitor disclosed by Fujiwara et al. in Fig. 2A by forming the dielectric layer 4 of tantalum oxide, an oxide of anode 1 in view of Asami et al., referring to column 4, line 45. This rejection is traversed.

Applicants submit that the device disclosed by Fujiwara et al. does not resemble that claimed. In this respect, claim 1, has been clarified by reciting that the metal layer is in direct

contact with the dielectric layer. Clearly, the structure defined in independent claim 1, the only independent claim, is neither disclosed nor suggested by Fujiwara.

Specifically, in the relied upon Fig. 2A structure of Fujiwara et al., the metal layer 8a is not, repeat not, in direct contact with the surface of dielectric oxide layer 4. Further, Applicants note that in the structure disclosed by Asami et al. in Fig. 3, the silver paste layer 6 is not in direct contact with the surface of dielectric oxide layer 6. It should, therefore, be apparent that even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 1, 2, 5, 6 and 8 under 35 U.S.C. §103 for obviousness predicated upon Fujiwara et al., in view of Asami et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 3 and 4 were rejected under 35 U.S.C. §103 for obviousness predicated upon Fujiwara et al. in view of Asami et al. and Deffeyes et al.

Claim 7 was rejected under 35 U.S.C. §103 for obviousness predicated upon Fujiwara et al., in view of Asami et al. and Fig. 2B of Fujiwara et al.

The above rejections of claim 3 and 4 of claim 7 are traversed. Specifically, claim 3 and 4 and 7 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §103 for obviousness predicated upon Fujiwara et al. in view of Asami et al. The additional reference to Deffeyes et al. and as well as the additional reliance upon Fig. 2B of Fujiwara et al. do not cure

Application No.: 10/810,639

the previously argued deficiencies in the attempted combination of Fujiwara et al. and Asami et al.

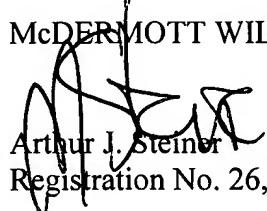
Applicants, therefore, submit that the imposed rejection of claim 3 and 4 under 35 U.S.C. §103 for obviousness predicated upon Fujiwara et al. in view of Asami et al. and Deffeyes et al., and the imposed rejection of claim 7 under 35 U.S.C. §103 for obviousness predicated upon Fujiwara et al. in view of Asami et al. and Fig. 2B of Fujiwara et al., are not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing, it should be apparent that the imposed rejections have been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Arthur J. Steiner
Registration No. 26,106

**Please recognize our Customer No. 20277
as our correspondence address.**

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AJS:ntb
Facsimile: 202.756.8087
Date: April 14, 2005